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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,057	07/12/1999	JACEK SLON-USAKIEVICZ	06942/021001	9179

7590

12/03/2002

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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/351,057

Applicant(s)

SLON-USAKIEVICZ ET AL.

Examiner

Cybille Delacroix-Muirheid

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-9 and 28-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-41,43 and 44 is/are allowed.
- 6) ☒ Claim(s) 6 and 8 is/are rejected.
- 7) ☒ Claim(s) 2,4, 5, 7, 9, 28 and 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The following is responsive to Applicant's amendment received Sep. 11, 2002.

Claims 1, 3 and 10-27 are cancelled.

New claims 28-44 are added.

Claims 2, 4-9 and 28-44 are currently pending.

The previous claims rejection under 35 USC 103(a) set forth in paragraphs 4-6 of the office action mailed Jul. 31, 2001 and maintained in the rejection mailed March 26, 2002 is withdrawn in view of Applicant's amendment and the remarks contained therein.

The previous claim rejection under 35 USC 112, paragraph 2, set forth in paragraph 3 of the office action mailed March 26, 2002 is withdrawn in view of Applicant's amendment and the remarks contained therein.

New Ground of Rejection

Applicant's amendment necessitated the following new ground of rejection:

Claim Objections

1. Claims 28, 42 and 2, 4-9 are objected to because of the following informalities: in claim 28, the bond between the "C" and the "X" is askew. As presented, claim 28, sets forth a compound having a "(L)n--X" bond. In claim 42, line 2, "said bound compounds" should read -- said bound compound--. Assuming claim 5 is to depend from claim 28, it is respectfully submitted that claim 5 does not further limit claim 28 because SEQ ID NO: 2 has been

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incorporated into claim 28. Claim 5 should be cancelled. Finally, claims 2 and 4-8 are dependent on cancelled claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 6 and 8 recite the limitation "R2 is comprised ofSEQ ID NO: 3" and "R2 is comprised of..... SEQ ID NO: 5" in lines 1-2. There is insufficient antecedent basis for these limitations in the claim.

Allowable Subject Matter

Claims 28-44 and (2, 4-9, if ultimately dependent upon claim 28) are free from the prior art because the prior art does not disclose or fairly suggest Applicant's claimed compounds and methods of use.

Conclusion

Claims 6 and 8 are rejected.

Claims 28, 42 and 2, 4-9 are objected to.

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4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM



Dec. 1, 2002



RAYMOND HENLEY, III
PRIMARY EXAMINER
GROUP 1400